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10/758,295	01/15/2004	Masami Kashiwazaki	CANO:114	5169

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EXAMINER
ZHU, RICHARD Z

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 March 2009</u>.
2a)☐ This action is **FINAL**.　　　　2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-3,5 and 8-14</u> is/are pending in the application.
　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-3,5 and 8-14</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a)☐ All　b)☐ Some * c)☐ None of:
　　　1.☐ Certified copies of the priority documents have been received.
　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.
　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date <u>03/31/2009</u>.
4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under, including the fee set forth in 37 CFR

   1.17(e), was filed in this application after final rejection. Since this application is eligible

   for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

   has been timely paid, the finality of the previous Office action has been withdrawn

   pursuant to 37 CFR 1.114. Applicant's submission filed on 03/23/2009 has been

   entered.

Status of the Claims

2. Claims 1-3, 5, and 8-14 are pending in the instant application.

Response to Applicant's Arguments

3. The examiner has carefully reviewed the final rejection. As a result, previous grounds of

   rejection are vacated and the examiner enters a new ground of rejection in light further

   search.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

   rejections set forth in this Office action:

   > (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
   > section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
   > such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3, 5, and 9-14 are rejected under 35 USC 103 (a) as being unpatentable over *Kuzma (US 5781901 A)* in view of *Seder et al. (US 6522770 B1)* and *Nelson et al (US 7149980 B1)*.

Regarding Claims 1, 11 and 12 as well as the image information processing apparatus of Claim 14, *Kuzma* discloses a document management system in which communication such as file transfer between nodes are facilitated by emails with attachments **(Fig 1 and see Col 2, Rows 25-55 and Col 4, Rows 50-64)** comprising:

a host computer **(Fig 2 and see Col 3, Rows 31-43, any one of the plurality of networked personal computers)**;

an image information processing apparatus **(Fig 2 and see Col 3, Rows 31-43, any one of the plurality of networked personal computers)**;

a document management server that manages electronic document data **(Fig 3, WWW HTTP Servers 310 and 320 and see Col 4, Rows 15-20, enabling user to search graphical and text based files that are linked together)**; and

a network that connects said host computer, said image information processing apparatus, and said document management server to each other **(Fig 3, Internet 301)**;

wherein said image information processing apparatus comprises:

a search device that searches the electronic document data within said document management server for an original electronic document data file **(Col 4, Rows 13-19, a web browser application that allows the user to search graphical and text based files)**;

a setting device (**Col 2, Rows 29-31, each of the nodes is a computer comprising a processor implementing the functions of setting via mouse and keyboard**), based on a user operation (**Col 5, Rows 45-50, the user at the recipient side decides whether or not to view an actual attachment of file that is associated by reference to a received email**), whether or not a searched original electronic document data file is to be attached to an electronic mail notification (**Col 6, Rows 40-53, the user decides whether or not as if an attachment is to be attach to the original email by value rather than by reference**); and

an operating section that displays a result of a search by said searching device (**Col 4, Rows 1-28, a graphical interface implemented by a computer for allowing users to view information and thus allow further search and retrieval**), including a first option for transmitting the result of the search as an electronic mail notification with the searched original electronic document data file (**Col 6, Rows 40-60, if a user chooses to view an attachment, he/she has the option to access attachment reference 402 just as if attachment 520 had originally been attached by value to email message 401. Attachment by value means attachment is actually attach to the original email message, see Col 5, Rows 1-15**) and a second option for transmitting the result of the search as an electronic mail notification without the searched original electronic document data file (**Col 5, Rows 1-15 and Rows 45-50, if a user chooses not to view email attachment as suggested in Col 4, Rows 49-64, then the email is in its default setting of referencing an attachment by reference via attachment reference 402 and hence the actual attachment 420 is not transmitted along with the email**);

a notifying device that transmits the result of the search by a searching device (**Col 4,**

Rows 15-20, the web browser application implemented by computer to search over the

internet for files) as an electronic mail to an electronic mail address when one of the first or

second option displayed in said operating section is operated by a user even if said setting

device sets that the electronic mail notification is not automatically executed (**Col 5, Rows**

45-50, sending notification by email with attachment by reference or by value on the

basis of user preference, see also Col 6, Rows 40-52), the result of search including

information indicative of a location where the searched original electronic document data is

stored (**Col 5, Rows 10-15, attachment reference 402 contains a pointer indicative of the**

actual location of searched file over the internet),

wherein the searched original electronic document data file is attached to the

electronic mail to be transmitted file by said notifying device when said setting device sets

that the searched original electronic document data file is to be attached or when the first

option is operated by the user (**Col 6, Rows 40-52, attachment by value as if the**

attachment has been attached to the original email message for all practical effect,

function, or purpose), and

wherein no file corresponding to the searched original electronic document data file is

attached to the electronic mail to be transmitted by said notifying device when said setting

device sets that the searched original electronic document data file is not to be attached or

when the second button is operated by the user (**Col 5, Rows 1-15 and Rows 45-50, if the**

user opt not to view the attachment, then the actual attachment 420 is never attach to

the email since reference attachment 402 is not the actual attachment 420).

Kuzma does not disclose an image information reading device that reads image information, a setting device that sets in advance, based on a user operation, whether or not the searched original electronic document data file is to be attached to an electronic mail notification.

Seder discloses a document management system (**Fig 1, System 10**) comprising:

an image information processing apparatus (**Fig 1, Computer 20**);

a document management server that manages electronic document data (**Fig 1, Database 18 and see Col 3, Rows 10-15**); and

a network that connects said image information processing apparatus, and said document management server to each other (**Col 3, Rows 10-15 and Rows 39-45, database located at remote computers linked together via the internet**);

wherein said image information processing apparatus comprises:

an image information reading device that reads image information (**Col 3, Rows 21-25 and Col 4, Rows 10-12, an optical sensor for reading textual and watermark data**);

a searching device that searches the electronic document data within said document management server for an original electronic document data file corresponding to the read image information (**Col 3, 20-38, a software program for decoding a read printed file and for querying the database for an electronic version of the printed file**).

Similar to *Kuzman, Seder* teaches a networked computer environment in which a database or server computer provides stored electronic information at a remote location over the network that is available for retrieval at the whim of a user. It would've been obvious to one of ordinary skill in the art at the time of the invention to modify Kuzman to include the

image information reading device of Seder and to implement the search device as taught

because this configuration provides an easy and efficient method of retrieval since it does not

require a user to remember the filename of the file he/she desires in order to retrieve it

(*Seder*, **Col 1, Rows 20-25 and 45-50**).

In the instant action, the limitation "whether or not the electronic mail notification is

automatically executed" is given a much narrower interpretation. Specifically, the

interpretation is tailored to avoid the fact that *Kuzman* (**since electronic mail notification is**

automatically executed by the computer, it is only a question of automatic execution by

reference or by value) can be interpreted to meet the claimed limitation.

Kuzma does not disclose the setting device that sets in advance, based on a user

operation, whether or not the searched electronic mail notification is automatically executed

and that the first option of attachment by value and the second option of attachment by

reference is implemented in a graphical interface in the form of electronic buttons or a first

button and a second button.

Nelson discloses a document management system (**For example Fig 2**) comprising:

an image information processing apparatus (**Fig 2, any of desktop, laptop, and**

handheld computers 97, 98, 99, see Fig 3 and Col 7, Rows 56-67);

a document management server that manages electronic document data (**Fig 2,**

Server 30); and

a network that connects said image information processing apparatus, and said

document management server to each other (**Fig 2 Internet 52**);

a graphical interface in the form of internet web browser implemented by a software application on the image information processing apparatus (**Col 9, Rows 40-56, browser software implemented on desktop, laptop or hand held computers**) in the form of electronic buttons (**Col 10, Rows 47-63, see also Fig 5, button 207**).

It would've been obvious to one of ordinary skill in the art at the time of the invention to modify the graphical user interface of *Kuzma* (**Col 4, Rows 1-28**) in the mode of *Nelson* as shown in at least Fig 5 to have electronic buttons as iconic representations of functional operations to send an email with the first option of sending email with the attachment by a first electronic button and the second option of sending email with no attachment by a second electronic button.

Nelson further discloses a setting device that allow users to set in advance whether or not automatic email notification (**Fig 2, IDD 40 at the server and keyboard or mouse at the laptop, desktop, or handheld computer, Col 8, Rows 45-58**) should be executed when a document, data, or service desired by the user was modified or updated (**Col 12, Rows 1-45**).

It would've been obvious to one of ordinary skill in the art at the time of the invention to modify the setting device of Kuzma so that a user can set in advance, whether or not the search result should be notified to the user by a auto email notification or by an email with attachment by value so as to provide a setting device that enable a user to designate whether or not they wish to receive information in a manner as they see fit (*Nelson*, **Col 12, Rows 1-6**).

Regarding the program stored on a computer readable medium, *Kuzma* discloses

a programmable processor implementing instructions from an email application program

stored in a hardware computer (*Kuzma,* **Col 3, Rows 5-43**).

Regarding Claims 2 and 3, *Kuzman* does not disclose the searching device

comprises a character recognition device and a watermarked information sensing device.

Seder discloses a character recognition device (**Col 4, Rows 8-14 and 28-40, looking**

for text that resembles a hyperlink by reading a printed document) and a watermarked

information sensing device (**Col 3, Rows 21-25**) within the image information process

apparatus comprising the search device.

It would've been obvious to one of ordinary skill in the art at the time of the invention

to incorporate the character recognition device and watermarked information sensing device

into the image information processing apparatus of *Kuzman* in order to recall an electronic

version of the printed document read (*Seder,* **Col 4, Rows 11-14**).

Regarding Claim 5, *Kuzman* discloses wherein said notifying device displays the

result of search in said operating section (**Col 6, Rows 43-52, viewing the attached**

document via a graphical display).

Regarding Claim 9, *Kuzman* does not disclose a printing device and a controller for

controlling the printing device.

Seder discloses wherein said image information processing apparatus further

comprises:

a printing device (**Fig 1, Printer 14**); and

a controller operable when the original electronic document data file corresponding to the read image information is present within said document management server, to cause said printing device to print the original electronic document data file (**Fig 1, Printer Driver 14 and see Col 3, Rows 30-38 and Col 4, Rows 33-54 and Col 5, Rows 8-14, the printer driver monitors print data for text, search the database for document matching the text, and cause the printer to print if demanded to do so**).

It would be desirable to incorporate the printer and the printer driver into the information processing apparatus of *Kuzman* so as to provide an alternative method of presenting the document to the user.

Regarding Claim 10, *Kuzman* discloses wherein said image information processing apparatus comprises:

a storage device (**Col 2, Row 29, memory 117**); and

a controller operable when the original electronic document data file corresponding to the electronic document data within the read image information is present within said document management server, to provide control to store data obtained by rendering the original electronic document data in said storage device (**Col 6, Rows 46-48, presumably, creating a local copy of the attached document require storing said document in a local memory**).

Regarding Claim 13, *Kuzma* discloses the user operation is executed via a web browser (**Col 4, Rows 14-20**) of an external computer that is connected via the network to the image information processing apparatus (**Fig 6 and see Col 12, Row 59 – Col 13, Row 2**).

6. Claim 8 is rejected under 35 USC 103 (a) as being unpatentable over *Kuzma (US 5781901 A)* in view of *Seder et al. (US 6522770 B1)* and *Nelson et al (US 7149980 B1)* and further in view of *Cullen et al. (US 5893908 A)*.

  Regarding Claim 8, *Kuzman,* as modified by *Seder*, would disclose wherein in a case where a plurality of original electronic document files corresponding to the electronic document data within the output image information are searched out, the result of search includes correspondence information according to degrees of correspondence (**Seder, Col 5, Rows 1-14, generating in real time, an index or table of contents to all documents printed by a given printer that is relevant to text read from a printed data filed by the optical sensor**).

  The combined teaching does not suggest the correspondence information is indicative of priorities according to degree of correspondence.

  Cullen teaches wherein in a case where a plurality of original electronic document files corresponding to the electronic document data within the output image information are searched out, the result of search includes correspondence information indicative of priorities assigned to the plurality of original electronic document files according to degrees of correspondence (**Col 5, Rows 27-50. The system lists the search results in descending order where the document with the most descriptors matching the user's document of interest is at the top**).

  Therefore, it would've been obvious to one ordinarily skilled in the art at the time of invention to adapt the method of listing search results base on matching descriptors as suggested by *Cullen* to the modified in order to have "an electronic document management

system that takes advantage of advanced document analysis techniques" (*Cullen,* **Col 1,**

Rows 64-65) to facilitate the process of identifying the correct document being desire.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to examiner Richard Z. Zhu whose telephone number is 571-270-1587 or

examiner's supervisor King Y. Poon whose telephone number is 571-272-7440. Examiner

Richard Zhu can normally be reached on Monday through Thursday, 6:30 - 5:00.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information

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access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or

571-272-1000.

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04/08/2009   Assistant Examiner
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